

*Commissioner for Patents
Amendment dated February 7, 2006
Response to Office Action dated October 7, 2005
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*Serial No.: 09/891343
Art Unit: 3629
Examiner: Brooks
Docket No.: AUS9 2001 0349 US1*

REMARKS/ARGUMENTS

Claims 1-22 were pending and examined. The Office Action indicated objections to claims 9, 10, 12, and 16. The Office Action rejected claims 1-10, 13, and 17-22 under 35 USC § 112, first paragraph, as failing to comply with the enablement requirement. Claims 1-22 were rejected under 35 USC § 101 as being directed to non-statutory subject matter. The Office Action rejected claims 1-22 under 35 USC § 103(a) as being unpatentable over "Accelerate Your Product-to-Market Process"; Larson, Mellisa; Quality, v. 36, n. 10, p. 38-40, hereinafter, "Larson".

Claim Objections

The Office Action indicated objections to claims 9 and 10 under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.

With respect to claim 9, Applicant believes that the objection is improper. The Office Action states that claim 9 fails to further limit the subject matter because "Applicant is already 'compensating'." Applicant disagrees. Whereas claim 1 recites compensating an innovator of the reusable design when a decision not to re-use an existing design is made, claim 9 recites compensating the innovator of an existing design when a decision is made to re-use an existing design. These are clearly two different compensations and Applicant requests the Examiner to reconsider and withdraw the objection to claim 9.

Similarly, with respect to claim 10 as amended, the recited compensation is for the designer who re-uses an existing design, which is different than the compensation to the designer of the re-used design. Accordingly, Applicant contends that the objected to claims do further limit their respective parent claims.

The Office Action indicated an objection to informalities in claims 12 and 16 as filed. In response, Applicant has amended claims 12 and 16 along the lines helpfully suggested by the Examiner. Applicant wishes to thank the Examiner for diligently reviewing the application and discovering these errors. Applicant submits that claims 12 and 16 as amended addresses the objections raised by the Examiner and Applicant would respectfully request the Examiner to reconsider and withdraw the objection.

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Claim rejections under 35 USC § 112

The Examiner rejected claims 1-10, 13, and 17-22 under Section 112, first paragraph, as failing to comply with the enablement requirement. In response, Applicant has canceled claims 17-22 and amended independent claim 1 by removing the limitation reciting determining a value of a reusable design. Consistent with the Office Action's indication that the broad recitation of determining a value in the originally presented claims, in light of the disclosure's indicating that determining a value for an internal consumer would entail "some valuation method," Applicant submits that the amended claim overcomes the rejection by removing the language from the claim.

Claim rejections under 35 USC § 101

The Examiner rejected claims 1-22 under Section 101 because the claimed invention is directed to non-statutory subject matter. In response, Applicant has amended the claims to recite explicitly that the claimed methods are computer implemented methods. In addition, claim 1 has been amended to eliminate the determination of a value. Applicant submits that this amendment addresses the Office Action's statement that Applicant's disclosure wherein the value upon which compensation was based could be a price paid by a consumer or some other methodology rendered the claim limitation "determining a value" non-statutory because it encompassed the abstract "some other methodology" language in the specification.

Claim rejections under 35 USC § 103(a)

The Examiner rejected claims 1-22 under Section 103(a) as being unpatentable over Larson.

In response to the rejection of independent claim 1, Applicant traverses the rejection because the reference does not teach or suggest all features recited in the claims. Specifically, whereas claim 1 recites using compensation to promote the design of re-useable components, Larson explicitly advocates encouraging designers to re-use already existing components. In other words, the incentive emphasized in claim 1 is for designers to create new designs which are

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re-useable. This incentive is contrary to the reference's focus on reducing design times by encouraging designers to re-use existing components.

Moreover, the Office Action correctly acknowledges that Larson fails to teach the use of compensation to encourage employees to re-use components. The Office Action takes official notice that it would have been obvious to motivate employees to re-use components by compensating them. As the Office Action concludes, "the use and advantages of compensation are well known." Applicants respond that the use of compensation is not obvious because compensation adds directly to the cost of the product and therefore is contrary to one of the fundamental goals of business entities, which is to minimize costs. By explicitly reciting the use of compensation as a means for encouraging re-useable designs, Applicant's invention recognizes that the value achieved by reducing design times through re-using components is sufficient justification for the increase in costs represented by the compensation. This recognition is not at all obvious simply because everyone likes money. Applicant respectfully requests the Examiner to reconsider and withdraw the obviousness rejection of independent claim 1.

In addition to the foregoing, Applicant respectfully traverses the Section 103(a) rejections of the dependent claims. The Office Action obviousness rejection addresses only the compensation limitations of the independent claims. The Office Action is entirely silent on any of the limitations in the dependent claims. Thus, for example, the Office Action does not indicate how the cited reference teaches or suggests the limitations of claim 4 (increased head count as compensation), claim 5 (incorporating standardized interfaces), and claim 6 (incorporating performance features that exceed the performance requirements of the original design). Applicant respectfully requests reconsideration of the Section 103(a) rejection of the dependent claims.

In addition to the foregoing, Applicant has added new independent claim 23 which recites limitations neither taught nor suggested by the cited references. Claim 23, unlike Larson, recites explicitly encouraging both the re-use of existing components and the design of components that are likely to be re-used in the future. Moreover, claim 23 as presented recites rewarding both innovator of a re-useable design and the person, group, or team that re-uses a design.

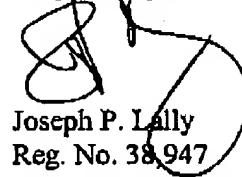
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CONCLUSION

In the present response, Applicant has addressed the objections to the claims, and responded to the Examiner's claim rejections under 35 USC §§ 112, 101, 103(a). Accordingly, Applicant believes that this response constitutes a complete response to each of the issues raised in the office action. In light of the amendments made herein and the accompanying remarks, Applicant believes that the pending claims are in condition for allowance. Accordingly, Applicant would request the Examiner to withdraw the rejections, allow the pending claims, and advance the application to issue. If the Examiner has any questions, comments, or suggestions, the undersigned attorney would welcome and encourage a telephone conference at 512.428.9872.

Respectfully submitted,



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